



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,611	06/20/2001	Jason S. Dell	56145473-8	5343

26453 7590 01/15/2003

BAKER & MCKENZIE
805 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT PAPER NUMBER

2876

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,611

Applicant(s)

DELL, JASON S.

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-13,15-18 and 20-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7-13,15-18 and 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Applicant: Dell

Filing date: 6/20/01

Claim Rejections - 35 USC § 103

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 Claims 1, 7-13, 15-18, and 20-32 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent Application Publication #2002/0059366 to Yap ("Yap" hereinafter) and U.S. Patent #5,884,271 to Pitroda ("Pitroda" hereinafter), each in view of the other. Yap teaches a smart card having a memory and a processor for executing different application programs stored in the memory, a method of using the stored application programs, the method comprising:

15 receiving in a smart card one of a plurality of application programs from an external system;

20 receiving in the smart card a plurality of symbols representing the plurality functions of one of the application programs from the external system; and

25 displaying on a display of the smart card the plurality of received symbols for identification of the functions of the application program by a user. While Yap teaches the use of a general purpose card for several different applications, Yap does not clearly teach that a plurality of those applications may be loaded on the same card. Pitroda teaches a multiple application smart card which has a display for displaying several applications (credit, bank, medical, etc.) loaded on the smart card, otherwise meeting the limitations of the claims, but does not teach that these constitute "icons". It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the load a plurality of the applications

taught by Yap on the same card taught by Yap, as suggested by Pitroda, because this would increase the versatility and utility of the card, as taught by Pitroda. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use "icons" as taught by Yap on the card taught by Pitroda, because icons help the user visually associate a
5 button with a function, as taught by Yap, where a function is the equivalent of an application in the combined teachings. In other words, "call mom" and "call dad" could be equivalently thought of as functions or applications of the card.

With respect to the positioning based on various concerns, these uses of icons were notoriously old and well known in the art at the time the invention was made. For example,
10 versions of the Windows operating system would perform all of these functions. Microsoft was known to trade icon presence and position on the desktop operating system, for example for Internet Service Provider set-up icons, for valuable favors. Versions of the operating system such as ME would display icons more prominently based on the frequency of use or the last use. Since Microsoft's graphical user interface has been determined to be a monopoly in court, it is
15 considered notoriously well known in the computer arts.

Examier has provided several documents in support of this taking of Official Notice,
below.

20 The prior art made of record is considered pertinent to applicant's disclosure.

"Taskbar Basics" has been cited for showing the customization of Windows ME using the Quick Launch bar.

"Disable personalized menus" is cited for showing that Windows moves recently used
25 icons to the top [first] of the menu, and hides items not recently used.

"Adjust taskbar and Start menu options: [Windows Millennium Edition, Windows Me]" has been cited for showing the availability of "personalized menus" and "favorites" in Windows Me. The screen shot of this web page aslo shows a multiplicity of icons on the task bar, the Office 2000 Toolbar, and within Netscape, including a large icon leading to the Netscape home

page.

The "Screenshot of Examiners Desktop" is cited for showing a typical Windows configuration.

"Who owns the desktop?" is cited for showing the well known economic value of placement of icons within Windows.

"MS is NOT price gouging on Windows - DoJ expert" is cited for showing that it was known that companies such as AOL signed deals with Microsoft for icon placement.

"Farewell to FUD" is cited for showing Microsoft economically values icon placement in dealings with others.

Response to Arguments

Applicant traverses the Examiners findings on the well known uses of Icons by, for example, Microsoft. Examiner has provided references in support.

Applicant asserts that the MS Windows operating systems "are not in the field of smart card technology..." The Examiner respectfully disagrees. If smart cards may contain icons as part of a graphical user interface, then the teachings and lessons of MS Windows operating systems with respect to graphical user interfaces and icons are within the field of Smart Cards. The assertions that the rejection fails to provide teachings for the recited uses of icons fail to persuade the Examiner because of the evidence provided of what is well known in the art.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.


MARK TREMBLAY
PRIMARY EXAMINER

January 13, 2003